UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,046	01/25/2002	Katsumi Kanasaki	RCOH-1044	3429

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EXAMINER
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ART UNIT	PAPER NUMBER
2141	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

Office Action Summary	Application No.	Applicant(s)
	10/057,046	KANASAKI, KATSUMI
	Examiner	Art Unit
	Ranodhi Serrao	2141

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 August 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 28 August 2007 have been fully considered but they

are not persuasive.

2.   Applicant remarked,

> Independent claims 1 and 12 explicitly recite "the newly generated address
> definition including some components based upon the corresponding
> predetermined rule definition and the corresponding conditions...." Independent
> claims 21 and 22 similarly recite "the newly generated address definition
> including some components based upon the corresponding predetermined rule
> definition and the corresponding condition." In other words, a new address is
> "automatically" generated according to a predetermined rule and a
> predetermined condition.

3.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., a new address is "automatically" generated according to a predetermined rule and

a predetermined condition) are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993). The claim language does not in any way suggest or imply that "a new address is

"automatically" generated according to a predetermined rule and a predetermined

condition." The claim language states, automatically generating a new address

definition, which is very much different from automatically generating a new address.

4.   In reference to Taylor et al., Applicant stated,

> The only existing mail addresses are stored, and no new mail addresses are
> "automatically" generated.

5.   As shown above, the claims do not recite that **a new address** is "automatically"

generated according to a predetermined rule and a predetermined condition, therefore,

Taylor does not need to teach this limitation.

6.   Applicant further argued,

> In contrary to the Examiner's characterization, the Applicant respectfully submit
> that the first alleged portion of the Taylor et al. reference thus fails to teach,
> disclose or suggest "a new address definition based upon the corresponding
> conditions at the second device."

7.   In col. 23, lines 53-56, Taylor et al. states, "The present invention allows

automatic integration of new service providers, e.g. service providers for electronic

mail services and fax connections." Emphasis added. Further in col. 24, lines 5-49,

Taylor et al. teaches a new address definition (a "package") based upon the

corresponding conditions (a service DLL 1702 invokes the methods of Service type

address card 1701 to retrieve service specific parameters) at the second device.

Therefore, Taylor et al. teaches automatically generating a new address definition

based upon the corresponding predetermined rule definition and corresponding

conditions at the second device.

8.   Applicant moreover stated,

> Thus, in contrary to the Examiner's characterization, the Applicant respectfully
> submit that the second alleged portion of the Taylor et al. reference again fails to
> teach, disclose or suggest "the newly generated address definition including
> some components based upon the corresponding predetermined rule definition
> and corresponding conditions."

9.   In col. 24, lines 5-49, Taylor et al. teaches the newly generated address definition

(a "package") including some components ("GetNote", "GetDistList", "GetAttachments",

etc.) based upon the corresponding predetermined rule definition (which conform to the format requirements of the communication service to which the package is intended) and corresponding conditions (a service DLL 1702 invokes the methods of Service type address card 1701 to retrieve service specific parameters). Thus, Taylor et al. teaches all of the mentioned claim limitations.

10.   In conclusion, upon taking the broadest reasonable interpretation of the claims, the cited references teach all of the claimed limitations. And the rejections are maintained. See below.

Claim Rejections - 35 USC § 103

11.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12.   Claims 1, 2, 12, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. (5,752,059) and Taylor et al. (5,754,306).

13.   As per claim 1, Holleran et al. teaches a method of flexibly managing addresses for a communication system (see Holleran et al., col. 3, lines 26-52), comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition based upon the corresponding predetermined rule definition at the second

device (see Holleran et al., col. 8, lines 46-65); and returning the newly generated address definition from the second address to the first device (see Holleran et al., col. 9, lines 13-23). But fails to teach generating a new address definition based upon the corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions. However, Taylor et al. teaches automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

14.   As per claim 2, the above-mentioned motivation of claim 1 applies fully in order to combine Holleran et al. and Taylor et al. Taylor et al. and Holleran et al. teach a method of flexibly managing addresses for a communication system, wherein the addresses

include e-mail addresses, document folders, telephone number and fax numbers (see

Taylor et al., column 10, lines 28-34).

15.   As per claim 12, Holleran et al. teaches a system for flexibly managing

addresses for a communication system, comprising: a third device sending a re quest

for an address definition for use with a predetermined operation; a second device

connected to said third device for receiving the request for the address definition and

sending the request for the address definition (see Holleran et al., col. 3, lines 26-52);

and a first device connected to said second device for returning the address definition

containing a plurality of components to said second device in response to the address

definition request (see Holleran et al., col. 5, lines 40-64), said first device further

including a address maintenance unit for maintaining address information (see Holleran

et al., col. 4, line 55-col. 5, line 3); wherein said second device obtaining a

corresponding predetermined rule definition for the address definition to generate a new

address (see Holleran et al., col. 8, lines 1-20) and automatically generating a new

address definition based upon the corresponding predetermined rule definition (see

Holleran et al., col. 8, lines 46-65), said second device returning the newly generated

address definition to said third device (see Holleran et al., col. 9, lines 13-23). But fails

to teach wherein said second device obtaining predetermined conditions for the address

definition to generate a new address, the newly generated address definition including

some components based upon the corresponding predetermined rule definition and the

corresponding conditions. However, Taylor et al. teaches wherein said second device

obtaining predetermined conditions for the address definition to generate a new address

(see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address

definition including some components based upon the corresponding predetermined

rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40).

It would have been obvious to one having ordinary skill in the art at the time of the

invention to modify Holleran et al. to wherein said second device obtaining

predetermined conditions for the address definition to generate a new address, the

newly generated address definition including some components based upon the

corresponding predetermined rule definition and the corresponding conditions in order

to provide an electronic address book which allows information to be efficiently sent to

users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines

11-24).

16.   As per claim 22, Holleran et al. teaches a computer readable medium storing

computer executable instructions for performing the task of flexibly managing addresses

for a communication system, the computer executable instructions comprising the steps

of: requesting an address definition from a second device to a first device; returning the

address definition containing a plurality of components to the second device from the

first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding

predetermined rule definition for the address definition to generate a new address (see

Holleran et al., col. 8, lines 1-20); automatically generating a new address definition

based upon the corresponding predetermined rule definition at the second device (see

Holleran et al., col. 8, lines 46-65). But fails to teach obtaining a corresponding condition

for the address definition to generate a new address, the newly generated address

definition including some components based upon the corresponding predetermined

rule definition and the corresponding condition; returning the newly generated address

definition from the second device to the first device, the address definition each has a

unique ID; determining whether or not an ID already exists; storing the newly generated

address if the ID does not exist; and replacing information with the newly generated

address if the ID exists. However, Taylor et al. teaches obtaining a corresponding

predetermined rule definition and a corresponding condition for the address definition to

generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly

generated address definition including some components based upon the

corresponding predetermined rule definition and the corresponding condition (see

Taylor et al., col. 24, lines 19-40); returning the newly generated address definition from

the second device to the first device, the address definition each has a unique ID;

determining whether or not an ID already exists; storing the newly generated address if

the ID does not exist; and replacing information with the newly generated address if the

ID exists (see Taylor et al., col. 29, lines 18-30). It would have been obvious to one

having ordinary skill in the art at the time of the invention to modify Holleran et al. to

obtaining a corresponding predetermined rule definition and a corresponding condition`

for the address definition to generate a new address, the newly generated address

definition including some components based upon the corresponding predetermined

rule definition and the corresponding condition; returning the newly generated address

definition from the second device to the first device, the address definition each has a

unique ID; determining whether or not an ID already exists; storing the newly generated

address if the ID does not exist; and replacing information with the newly generated

address if the ID exists in order to provide an electronic address book which allows

information to be efficiently sent to users of both electronic mail and facsimile

transmission (see Taylor et al., col. 3, lines 11-24).

17.   Claims 3, 4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Holleran et al. and Taylor et al. as applied to claim 1 above, and

further in view of Krishnaswamy et al. (5,999,525).

18.   As per claim 3, Holleran et al. and Taylor et al. teach the mentioned limitations of

claim 1 above but fail to teach wherein the first device is an existing user account

management unit for user account information. However, Krishnaswamy et al. teaches

wherein the first device is an existing user account management unit for user account

information (see Krishnaswamy et al., column 23, lines 37-47). It would have been

obvious to one having ordinary skill in the art at the time of the invention to modify

Taylor et al. and Holleran et al. to wherein the first device is an existing user account

management unit for user account information in order to attach individual systems for

billing, provisioning, directory services, messaging services such as voice messaging

via a communication link (see Krishnaswamy et al., col. 23, lines 23-36).

19.   As per claims 4, 10, and 11, the above-mentioned motivation of claim 3 applies

fully in order to combine Holleran et al., Taylor et al, and Krishnaswamy et al.

20.   As per claim 4, Holleran et al., Taylor et al., and Krishnaswamy et al. teach an

address maintenance unit that corresponds to the existing user account management

unit for managing address information (see Krishnaswamy et al., column 23, lines 37-47).

21.   As per claim 10, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein said generating the new address definition is performed prior to said requesting the address definition (see Krishnaswamy et al., column 108, lines 21-32).

22.   As per claim 11, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein the address definition each has a unique ID and further comprises additional steps of determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists (see Krishnaswamy et al., column 102, lines 50-67).

23.   Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnaswamy et al., Taylor et al., and Holleran et al. as applied to claims 1 and 4 above, and further in view of Ouchi (5,978,836).

24.   As per claim 5, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by adding a new delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by adding a new delivery method (column 12, lines 46-65). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by

adding a new delivery method in order to go off route and capture the optimal route of transmission.

25.   As per claim 6, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1, 4, and 5 as described above but fail to teach wherein the new delivery method is specified in the rule definition. Ouchi however teaches wherein the new delivery method is specified in the rule definition (column 8, lines 13-31). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the new delivery method is specified in the rule definition in order to insure that the value for the active document is unique.

26.   As per claim 7, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1, 4, 5, and 6 as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value. Krishnaswamy et al., however teaches wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value (column 99, line 58-column 101, line 16: wherein VNET numbers serve the function of a Condition value, unique ID serves the function of an ID value, IP address serves the function of a Source value, a Name Generation Method value, and a Type Generation Method value). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the rule

definition further includes or the address maintenance unit additionally manages an ID

value, a Source value, a Condition value, a Name Generation Method value, and a

Type Generation Method value in order to allow an user to register his/her computer as

"on-line" and available to receive calls.

27.   As per claim 8, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the

limitations of claims 1 and 4 as described above but fail to teach wherein the address

maintenance unit manages delivery methods by deleting an existing delivery method.

Ouchi however teaches wherein the address maintenance unit manages delivery

methods by deleting an existing delivery method (column 6, line 48-column 7, line 7). It

would have been obvious to one having ordinary skill in the art at the time of the

invention to modify the above limitation to add wherein the address maintenance unit

manages delivery methods by deleting an existing delivery method in order to permit

more than one concurrent use of a workflow route.

28.   As per claim 9, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al.

teach the limitations of claims 1 and 4, as described above but Ouchi, Taylor et al., and

Holleran et al. fail to teach wherein the address maintenance unit updates the address

information based upon the user account information. Krishnaswamy et al. however

teaches wherein the address maintenance unit updates the address information based

upon the user account information (column 41, lines 27-35). It would have been obvious

to one having ordinary skill in the art at the time of the invention to modify the above

limitation to add wherein the address maintenance unit updates the address information

based upon the user account information because cache copies must be refreshed

when the version is out of date.

29.   Claims 13-21 have similar limitations as to claims 1-12 and 22 above; therefore,

they are being rejected under the same rationale.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-

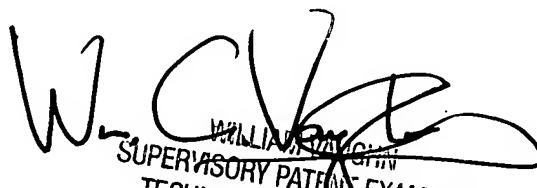7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RNS

R.N.S.

10/22/2007

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